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HOFFMAN WARNICK LLC
75 STATE ST
14TH FLOOR
ALBANY, NY 12207

EXAMINER

RUTTEN, JAMES D

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID N. SPIEGEL

Appeal 2009-012623
Application 09/708,129
Technology Center 2100

Before JOHN A. JEFFERY, CARLA M. KRIVAK, and
DENISE M. POTHIER, *Administrative Patent Judges*.

POTHIER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-20.¹ We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

Appellant's invention relates to maintaining software on a computer system. *See* Spec. 1:3-7. Claim 1 is reproduced below with the key disputed limitations emphasized:

1. A method of maintaining software on a computer system, comprising the steps of:
 - bringing up first and second host sessions on a computer system;
 - starting in said first host session, a software recording application having data on existing first maintenance items that have been previously applied to said computer system;
 - starting in said second host session, *a database application having a database of all second maintenance items that are known as being able to be installed on the computer system*, and prerequisite items and corequisite items corresponding to each of said known second maintenance items;
 - activating a maintenance application on said computer system;
 - entering a first list of new third maintenance items in said maintenance application;
 - searching said database of known second maintenance items for records matching each of said new third maintenance items to find records that have said prerequisite items and corequisite items and adding said corresponding prerequisite items and corequisite items to said first list;*
 - thereafter determining from said software recording application which items on said first list have already been received, and adding those items not received to an order list; and
 - thereafter ordering, receiving, and applying said items on said order list.

¹ Appellant states claims 1-18 are subject to appeal (App. Br. 2), but then discusses claims 1-20 (*see* App. Br. 6-9, 14-15). Appellant clarifies that claims 1-20 are being appealed. Reply Br. 1.

The Examiner relies on the following as evidence of unpatentability:

Taylor	US 5,721,824	Feb. 24, 1998
Stupek, Jr.	US 5,960,189	Sept. 28, 1999

J. Arthur Gowan et al., *Y2K Compliance and the Distributed Enterprise*, 42 Comms. of the ACM 68-73 (1999) (“Gowan”).

Jim Boyle et al., *IMS/ESA Sysplex Data Sharing: An Implementation Case Study* 31-32 (1997) (“Boyle”).

IBM SMP/E as described on page 8 of the originally filed specification (“SMP/E”).

THE REJECTIONS

1. Claims 1-20 are rejected under 35 U.S.C. § 112, ¶ 1 as failing to comply with the written description requirement.² Ans. 4-5.
2. Claims 1, 3-5, 7-9, 11-13, 15-18, and 20³ are rejected under 35 U.S.C. § 103(a) as unpatentable over Stupek and Taylor. Ans. 5-11.
3. Claims 2 and 10 are rejected under 35 U.S.C. § 103(a) as unpatentable over Stupek, Taylor,⁴ and Gowan. Ans. 11.
4. Claims 6 and 14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Stupek, Taylor, and Boyle. Ans. 12.
5. Claim 19 is rejected under 35 U.S.C. § 103(a) as unpatentable over Stupek, Taylor, and SMP/E. Ans. 12-13.

² Throughout this opinion, we refer to (1) the Appeal Brief filed October 15, 2007; (2) the Examiner’s Answer mailed December 28, 2007; and (3) the Reply Brief filed February 28, 2008.

³ The Examiner includes claims 6 and 14 in the header of the rejection (*see* Ans. 5) but does not discuss these claims in the body (*see* Ans. 5-11). Claims 6 and 14 are separately rejected. *See* Ans. 12.

⁴ Taylor is not included in the rejection’s heading. Ans. 11. Yet, claims 2 and 10 depend from claims 1 and 9, which were rejected using Taylor.

THE WRITTEN DESCRIPTION REQUIREMENT REJECTION

Regarding representative claim 1, the Examiner finds that Appellant does not have support in the disclosure for the limitation, “a database of all second maintenance items that are known as being able to be installed on the computer system” Ans. 4, 13-15. Specifically, the Examiner finds that there is no discussion that the database contains *all* known maintenance items or *known as being able to be installed*. Ans. 4. Appellant argues support for this disputed limitation is found explicitly and implicitly in the disclosure by describing a master or global database. App. Br. 8-9; Reply Br. 2.

As for claim 20, the Examiner finds that Appellant does not have support in the disclosure for the limitation, “the database is stored on a different medium than the maintenance application[,]” because there is no description of storage or medium requirements for the database or maintenance application. Ans. 5. Appellant counters that support is found at page 7, lines thirteen through fifteen. App. Br. 9.

ISSUES

(1) Did Appellant satisfy the written description requirement under 35 U.S.C. § 112, first paragraph by demonstrating the disclosure conveys with reasonable clarity to an ordinarily skilled artisan that Appellant was in possession of:

(a) “a database of all second maintenance items that are known as being able to be installed on the computer system” as recited in claim 1?

(b) “the database is stored on a different medium than the maintenance application” as recited in claim 20?

FINDINGS OF FACT (FF)

(1) Appellant states “the database application has a database of second maintenance items known as PTF’s[.] The database also includes a listing of prerequisite and corequisite items for each second maintenance item. The database may also include descriptions known as APARS, of known problems in software items and mention of known fixes.” Spec. 8:14-19.

(2) Appellant describes “[i]n step 12[,] two host sessions are brought up on a computer system. The computer system is normally the computer system on which one wants to perform software maintenance[;] however this is not required in order to practice the invention.” Spec. 7:12-15.

ANALYSIS

Claims 1-19

Based on the record before us, we find no error in the Examiner’s rejection of representative claim 1 which calls for, in pertinent part, a database of all second maintenance items that are known as being able to be installed on the computer systems. The original disclosure describes this database as having maintenance items known as PTFs, a listing of prerequisite and corequisite items for each second maintenance items, and descriptions of APARs of known problems in software items and known fixes. *See* FF 1. These discussions address maintenance items and known fixes and, arguably, an ordinarily skilled artisan would have recognized that these items are known as being able to be installed on the computer system.

Yet, this discussion fails to describe that the database has *all* second maintenance items that are known as being able to be installed on the

computer system. While the disclosure discusses the maintenance items are known as PTFs (FF 1), Appellant has not demonstrated that the term, PTFs, conveys to an ordinarily skilled artisan that the database includes *all* maintenance items as recited. *See* App. Br. 8. Moreover, Appellant's discussion (*see id.*) of the database being searched for items corresponding to each maintenance item on a list (Spec. 9:6-9) does not convey with reasonable clarity to an ordinary skilled artisan that the database is a global or master database. This discussion describes no more than searching the database for prerequisite and corequisite items and fails to discuss any further details about what the database contains. *See id.*

We further note the recited second and third maintenance items have not been defined in the Specification (*see generally* Specification) such that "the definition of second maintenance items of the claimed invention does not have the limitation of that of the third maintenance items" or vice versa. App. Br. 9. We, therefore, find that Appellant has not demonstrated the disclosure conveys with reasonable clarity to an ordinarily skilled artisan that Appellant had possession of the claimed database of all second maintenance items that are known as being able to be installed on the computer systems as recited in claim 1. *See Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (internal citations omitted).

For the foregoing reasons, Appellant has not persuaded us of error in the lack of written description rejection of independent claim 1 and claims 2-19 not separately argued with particularity.

Claim 20

Based on the record before us, we also find no error in the Examiner's rejection of representative claim 20, which recites the database is stored on a different medium than the maintenance application. Appellant asserts support for this limitation is found in the discussion of a computer system that brings up host sessions, which may or may not perform software maintenance. *See* App. Br. 9. However, we agree with the Examiner that this disclosure falls short of conveying with reasonable clarity to an ordinary skilled artisan that Appellant had possession of a database being stored on a different medium than the maintenance application.

As the Examiner states (Ans. 5), there is no discussion in this cited portion of any medium or on what type of medium the database and the maintenance application are stored. *See* FF 2. While the maintenance application may be on a different computer system than where the host session starts up as recited (*see id.*), the medium where the host session (i.e., where the database application starts up as recited) and the maintenance application are stored is not described and could be the same kind of medium. For the foregoing reasons, Appellant has not persuaded us of error in the lack of written description rejection of claim 20.

THE OBVIOUSNESS REJECTION OVER STUPEK AND TAYLOR

Regarding independent claim 1, the Examiner finds that Stupek teaches a database of known second maintenance items for records (i.e., Upgrade Database 9 (Ans. 6)) and a first list of new third maintenance items (i.e., Resource Upgrades 7 (Ans. 6)). Additionally, the Examiner finds that Stupek teaches an upgrade advisor (i.e., 11) analyzing and modifying the

first list to produce a report or list of prerequisites and corequisites and a set of necessary upgrades. Ans. 7-8. The Examiner also finds that Stupek does not teach adding the corresponding prerequisite and corequisite items to the first list and relies on Taylor to cure this deficiency. Ans. 9.

Appellant argues, among other things, that neither Stupek nor Taylor teaches adding the prerequisite and corequisite items to the first list. App. Br. 13. Particularly, Appellant states Taylor creates an action list that identifies dependent packets but does not add the packages to the original list of items (i.e., the first list of new third maintenance items). App. Br. 13.

ISSUE

Under § 103, has the Examiner erred in rejecting claim 1 by finding that Stupek and Taylor collectively would have taught or suggested adding the corresponding prerequisite and corequisite items to the first list of new third maintenance items?

ADDITIONAL FINDINGS OF FACT

(3) Stupek discloses upgrades 7 to network resources 3 are upgrade objects 8 and are grouped into upgrade packages 6. The upgrades are provided by a medium or on-line service, such as a bulletin board service. Stupek, col. 3, ll. 31-43; Fig. 1.

(4) Stupek also discloses an upgrade database 9 storing information about each upgrade package 6 and the individual upgrade objects 8 within each package 6. Stupek, col. 3, ll. 44-50; Fig. 1.

(5) Stupek teaches when upgrades 7 become available to the network, an upgrade advisor 11 automatically analyzes each network resource 3

currently on the server 1 to determine the availability and necessity of the corresponding upgrade 7. After analyzing, the upgrade advisor 11 presents a report to the user with upgrade recommendations. Stupek, col. 3, l. 57 – col. 4, l. 10; Fig. 1.

(6) To determine which upgrades 7 should be installed, Stupek explains the upgrade advisor 11 retrieves information from the management information base (MIB) 5 and the upgrade database 9. Stupek then teaches upgrade advisor 11 performs two comparisons: (a) whether or not a particular upgrade package corresponds to a resource on the server and (b) whether or not the version number of the upgrade package matches the version number of the corresponding network resource. Stupek, col. 4, ll. 11-27; Fig. 1.

(7) Stupek teaches selecting network resources 3 that need to be upgraded. Stupek discloses that several upgrade packages 7 and corresponding installation instructions 20 are grouped at 108 into a job 18. Stupek, col. 4, ll. 45-48; col. 5, ll. 41-47; Figs. 1, 3.

(8) Taylor teaches installing a distribution pack in a computing system, where a software package in the pack can be dependent on another dominant package in the pack and is called a dependent package. Taylor discusses building an action list of dependent packages to be installed and creating a trailer script to install the dependent packages on the action list. Taylor, col. 2, ll. 3-7, 13-23.

ANALYSIS

Based on the record before us, we find error in the Examiner's rejection of claim 1 which calls for, in pertinent part, adding the

corresponding prerequisite and corequisite items to the first list of new third maintenance items. The Examiner has mapped the database of all second maintenance items that are known to the upgrade database 9 (FF 4) and the first list of new third maintenance items to upgrades 7 (FF 3). *See* Ans. 6. Stupek's upgrades 7 have objects that can come from different sources, including a bulletin board service or include an upgrade list. *See* FF 3. Also, while Appellant asserts that Stupek's database 9 is not a database of all second maintenance items (App. Br. 9-11), we assume for purposes of this discussion that Stupek teaches or suggests such a database.

The Examiner further states that Stupek teaches searching the database for records to match each of the new third maintenance items to find records that have the prerequisite and corequisite items. Ans. 7. In particular, the Examiner relies on Stupek's discussion of determining when to install upgrades. *See* Ans. 7. Here, Stupek discusses the upgrade advisor retrieving upgrade information from the upgrade database and the MIB and performing comparisons with information related to resources on the server. *See* FF 6. However, as the Examiner admits (Ans. 9), there is no discussion of adding items to the upgrade list (i.e., 7), which is mapped to the recited first list (Ans. 7).

Yet, Taylor, when combined with Stupek, fails to teach adding the prerequisite and corequisite items found from searching the database of known second maintenance items to this mapped upgrade list (i.e., 7) as recited. Taylor teaches adding dependent packages to an action list. FF 8. This action list in Taylor is similar to a job list of packages to be installed and does not suggest adding such information to the upgrades 7 in Stupek. *See* FF 3. Nor do we find a suggestion in Taylor to add such information to

these upgrades 7, which are provided by the distribution medium or on-line service. *See id.*

In the context of discussing the first list, the Examiner also describes a report or yet another list in Stupek. *See* Ans. 7 (stating “[t]he first list is analyzed by the upgrade advisor and modified according to the current maintenance needs, producing a report, or list, of prerequisites and corequisites”); *see also* Ans. 8. However, this produced report or list is not used when searching the database of known second maintenance items for records matching each new third maintenance items of this first list, as claim 1 also requires. That is, because this list is generated after analyzing the database, Stupek does not teach or suggest searching a database for records that match each new third maintenance item in the list that has yet to be generated. *See* FF 5. Similarly, Stupek teaches or suggests selecting resources that need to be upgraded and creating jobs (e.g., a list of new third maintenance items). *See* FF 7. However, this jobs list is not used to search a database for records that match each new third maintenance items of this list to find records that have the prerequisite and corequisite items, as claim 1 requires. *See id.*

For the foregoing reasons, Appellant has persuaded us of error in the rejection of: (1) independent claim 1; (2) independent claims 9, 17, and 18, which recite commensurate limitations; and (3) dependent claims 3-5, 7, 8, 11-13, 15, 16, and 20 for similar reasons.

THE REMAINING OBVIOUSNESS REJECTIONS

Claims 2, 6, 10, and 14 depend from either claim 1 or 9; independent claim 19 recites limitations commensurate with those discussed above

regarding claim 1. The Examiner has not relied on Gowan, Boyle, or SMP/E to cure the noted deficiencies of claims 1 and 9. *See* Ans. 11-13. Because we reverse the Examiner's rejection of independent claims 1 and 9, we, likewise, will not sustain the rejections of claims 2, 6, 10, 14, and 19.

CONCLUSION

The Examiner did not err in rejecting claims 1-20 under § 112, first paragraph but erred in rejecting claims 1-20 under § 103.

DECISION

The Examiner's decision rejecting claims 1-20 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

gvw